REMARKS

The above Amendments and these Remarks are submitted under 35 U.S.C. § 132 and 37 C.F.R. §§ 1.111 and 1.114 in response to the Office Action mailed August 14, 2008.

Summary of the Examiner's Action and Applicants' Response

The Examiner objected to the Specification. Claims 17, 18, 19-25, 33-34, and 51-52 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The Examiner rejected Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51 -52 under 35 U.S.C. § 103(a) as being obvious based on by Landsman, et al. (U.S. Patent No. 6,317,761) ("Landsman"). The Examiner rejected Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 under 35 U.S.C. § 103(a) as being obvious based on Landsman in view of Galomb (U.S. Pat. App. Pub. 2001/0039510). Applicants respectfully traverse the rejections.

In this Amendment, Applicants have amended Claims 1, 5, 9, 13, 17-19, 22, 26, 29, 33-35, 39, 43, 47, 51, and 52. Claims 1-52 are pending.

Response to Objection to the Specification

The Examiner objected to the Specification as failing to provide proper antecedent basis for the claimed subject matter. More specifically, the Examiner stated that the phrases "memory" and "computer readable storage medium" are not found to have proper antecedent basis in the Specification; however "it is necessary to use this terminology in order to properly define the claim within the boundaries of statutory subject matter. In order to overcome the object, an amendment to the Specification is necessary constituting a non-exhaustive statement of what the phrases 'memory' and 'computer readable storage medium' would be as it would have been known to one of ordinary skill in the art at the time of the invention, in order to verify that the terms 'memory' and 'computer readable storage medium' could not be taken in the context of non-statutory subject matter".

Applicants respectfully submit that proper antecedent basis is provided for "memory" and "computer readable storage medium", each term of which is included in certain claims.

"What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail". M.P.E.P. § 2163 3(a), citing *Hybritech Inc. v. Monoclonal Antibodies, Inc.*,

802 F.2d at 1384, 231 USPQ at 94 and *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d
1078, 1085 (Fed. Cir. 2005).

Applicants respectfully submit that the terms "computer readable medium" and
"memory" are disclosed in the Specification, see e.g., page 7, lines 1-5 ("Advertising system
processor 26 comprises any conventional computer, for example **a personal computer, server
or mainframe, capable of performing the functions described below.** Similarly, advertising
database 28 and proprietary database 29 comprise **any conventional storage system** for storing
the data described below as well as software for performing the processes of the present
invention".) (Emphasis added). Applicants respectfully submit that it is well known that "any
conventional storage system", as disclosed, includes a computer readable medium and a
memory; and what is conventional or well known to one of ordinary skill in the art need not be
disclosed in detail. Moreover, the Specification describes a personal computer, server or
mainframe, which are respectfully submitted to be well known to contain computer readable
medium and memory.

Applicants respectfully submit, therefore, that the terms "computer readable medium"
and "memory" are disclosed in the Specification. Moreover, it is respectfully submitted that the
term "computer readable medium" and "memory" are well known in the art, therefore, the
definition of this term need not be disclosed in detail, see M.P.E.P. § 2163 3(a). For all of the
above reasons, it is respectfully request that the objection to the Specification be withdrawn.

Response to Rejection of Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 under 35 U.S.C. § 101

Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 were rejected under 35 U.S.C. § 101 for
being directed to non-statutory subject matter. The Examiner stated that "[t]he claims appear to
be claiming 'software systems' i.e., systems without hardware indication, which is a computer
program per se. Since the claims disclose computer program per se that is not embodied on a
computer readable medium, they appear non-statutory".

In the Response to Arguments on page 13 of the Office Action, the Examiner stated that:

> "... the specification failed to specifically disclose or mention the term "computer
> readable storage medium" or what a computer readable storage medium
> comprises at all; (i.e. memory, hard drive) thus, the claims are viewed as software
> in view of data structures. Furthermore, the claim language in the claims failed to
> disclose or mention what is included a system at all; thus, the claims are viewed

as software in view of data structures. The use of the word "system" does not inherently mean that claim is directed to a physical machine. Therefore, the claims, themselves, lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory. They are, at best, functional descriptive material per se. Thus, in regards to claims 1-8, 17-25, 33-34, and 51 -52, the claims, as written, appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program per se. The claims as written do not recite any hardware indication, therefore, viewed as "software systems".

Applicants respectfully submit that Claims 1, 17, 19, 33, 34, and 51 include that at least one creative definition is stored in at least one computer readable storage medium. Per M.P.E.P. § 2106.01, functional descriptive material such as data structures or computer programs, when recorded on some **computer readable medium**, including an electromagnetic carrier signal, become structurally and functionally interrelated to the medium and **will be statutory** in most cases "since use of technology permits the function of the descriptive material to be realized."

Regarding disclosure of "computer readable medium", as stated above, Applicants respectfully submit that **proper antecedent basis support is provided for "computer readable storage medium"** in the Specification, e.g., page 7, lines 1-5: "Advertising system processor 26 comprises any conventional computer, for example a personal computer, server or mainframe, capable of performing the functions described below. Similarly, advertising database 28 and proprietary database 29 comprise any conventional storage system for storing the data described below as well as software for performing the processes of the present invention". Moreover, "[w]hat is conventional or well known to one of ordinary skill in the art need not be disclosed in detail". M.P.E.P. § 2163 3(a), citing *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94 and *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005). Applicants respectfully submit that it is well known any conventional storage system, as disclosed, includes a computer readable medium. Moreover, the Specification describes a personal computer, server or mainframe, which are respectfully submitted to be well known to contain computer readable medium.

For all of the above reasons, Applicants respectfully submit, therefore, that Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 are directed to statutory subject matter, and that the term

"computer readable medium" is sufficiently disclosed.

Response to Rejection of Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, 51, and 52 under 35 U.S.C. § 103(a)

Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 were rejected under 35 U.S.C. § 103(a) as being obvious based on Landsman.

The Examiner acknowledged that Landsman fails to disclose performing the limitations on the server-side system. The Examiner added that:

> "On the other hand, Landsman discloses a client/server architecture in a networked environment (Col 15, lines 48-51) wherein the server can be a separate software application which executes on any computer in the networked environment. (Column 15, lines 61 -64) Therefore, It was well-known to one of ordinary skilled in the art at the time of Applicant's invention that the functionality of a client/server architecture is applicable and interchangeable between a client and a server since there is no real significant differences between the processing abilities of a client and a server. In addition, one of ordinary skill in the art would not see any reason why certain data processing techniques, once taught, cannot or should not be applied to either the client or server side of a system. Each side contains a data processing unit and techniques for one processing unit may very well be applicable to other data processing units; therefore, a program tailored to be executed on a client can also be executed on a server.
> It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modified Landsman's method to perform on a server since it would have provided the benefit of taking advantage of server capabilities of management and distribution duties with other clients that a server provides to a client".

Applicants respectfully disagree that the claims are obvious based on Landsman. Applicants have amended Claim 1 to make it more clear that the server-side system is for a publisher and the client-side system is for a viewer. Claim 1 includes that the server-side system and client-side system communicate through an electronic network. Claim 1 has also been amended to add elements from pending dependent Claim 5 with further clarification, such that Claim 1 includes transmitting the creative through the electronic network from the publisher on a server-side system to the viewer on the client-side system. Applicants respectfully submit that the transmitting in Claim 5 has already been searched by the Examiner, thus, the amendment to Claim 1 and to the other claims, does not necessitate a new search.

Applicants respectfully submit that Landsman does not teach or suggest a method in Claim 1, having the server-side system for a publisher and the client-side system for a viewer,

generating and executing the creative on the server-side and transmitting the creative through the electronic network from the publisher on a server-side system to the viewer on the client-side system, as claimed in Claim 1. Further, client side programmable technology, such as disclosed in Landsman, was described in the background of the Specification of the present application, see e.g., page 3, as having drawbacks overcome by the present invention. Referring to client-side programmable technology, such as that taught in Landsman, the present Specification states that:

> "[c]lient-side programmable technology, uses software programs that are authored on the server-side (either by the publisher or the advertiser or advertising agency), but are delivered to the client and executed on the client-side. Exemplary client-side programming platforms include JavaTM, JavaScript and FlashTM. Each constitutes an executable program which is downloaded into a client web browser along with an HTML web page and executed on that client computer. During execution, the programs may, for example, deliver motion video and/or audio and/or special effects. Their execution can create the appearance of something 'special' selected for the viewer. However, client- side programs have significant limitations to their flexibility and customizability. In particular: once downloaded, communication back to the publisher's internal data sources requires impractical server security configuration. Hence, it's not practicable to dynamically include private, internal data in client-side programmable creatives. Further, client-side programmable creatives typically require special client-side web browser plug-in software and resources to execute. In contrast, server-side programmable creatives, by comparison, require no additional client-side software or resources; perhaps more importantly, they have access to the publisher's private, internal data sources. (See Page 3, lines 11-29).

Further, Applicants respectfully submit that modifying Landsman's method to perform on a server, as suggested by the Examiner, would not have predictable results. More specifically, Applicants respectfully submit that Landsman requires authoring of creatives on the server-side, delivered to the client side, execution of the creative on the client side by special client-side web browser plug in software , e.g., java applet (Col. 16, lines 53-66) and resources. It is respectfully submitted that modifying Landsman's method to perform on a server, as suggested by the Examiner, such that generation and execution would be on the server-side, would not have predictable results in that it would not be predictable that the special client-side web browser plug in software taught in Landsman would operate properly on the server-side for generation and execution on the server-side of a creative that could be transmitted to a client-side for viewing by a viewer.

Moreover, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01 V. referencing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). It is respectfully submitted that the modification suggested by the Examiner would render Landsman unsatisfactory for its intended purpose for the reasons given above regarding the unpredictability of the results.

For all of the above reasons, Applicants respectfully submit that Claim 1 is non-obvious based on Landsman.

Claims 2-5 depend directly or indirectly from Claim 1 and are thus respectively submitted as being non-obvious based on Landsman for the same reasons as given for Claim 1 above.

Claim 9 is generally a system counterpart to Claim 1 and has been amended similarly to Claim 1 to emphasize the server-side system is for a publisher and the client-side system is for a viewer, the server-side system and client-side system communicate through an electronic network, and the creative that is generated and executed on the server-side is transmit through the electronic network from the publisher on a server-side system to the viewer on the client-side system, and thus it is respectfully submitted as being non-obvious based on Landsman for the same reasons given above for Claim 1. Claims 10-13 depend directly or indirectly from Claim 9 and are thus respectively submitted as being non-obvious based on Landsman for the same reasons as given for Claim 9 above.

Claim 17 is generally a system counterpart to Claim 1, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 1. Claim 18 is generally a program product counterpart to Claim 1, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 1.

Claim 19 is a method similar to Claim 1 and is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 1. Claims 20-22 depend directly or indirectly from Claim 19 and are thus respectively submitted as being non-obvious based on Landsman for the same reasons as given for Claim 19 above.

Claim 26 is generally a system counterpart to Claim 19, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 19.

Claims 27-29 depend directly or indirectly from Claim 26 and are thus respectively submitted as being non-obvious based on Landsman for the same reasons as given for Claim 26 above.

Claim 33 is generally a system counterpart to Claim 19, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 19. Claim 34 is generally a program product counterpart to Claim 19, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 19.

Claim 35 is a method claim and has been amended similarly to Claim 1, thus is respectively submitted as being non-obvious based on Landsman for the same reasons as given for Claim 1 above.

Claim 43 is generally a system counterpart to Claim 35, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 35. Claims 44-47 depend directly or indirectly from Claim 43 and are thus respectively submitted as being non-obvious based on Landsman for the same reasons as given for Claim 43 above.

Claim 51 is generally a system counterpart to Claim 35, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 35. Claim 52 is generally a program product counterpart to Claim 35, and thus is respectfully submitted as being non-obvious based on Landsman for the reasons given above for Claim 35.

Response to Rejection of Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 under 35 U.S.C. 103(a)

The Examiner rejected Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 under 35 U.S.C. 103(a) as being obvious based on Landsman in view of Galomb. The Examiner acknowledged that Landsman discloses the ability for an advertiser to change or update any of its advertisements by just modifying appropriate media and AdDescriptor files that reside in the third-party advertising management system. (Column 13, lines 55-66), however, Landsman does not disclose periodically changing text, an image, or a hyperlink within the creative, as claimed in Claim 1. The Examiner stated that Galomb discloses advertisement includes text, images, and/or hyperlinks. (Paragraph 0004). The Examiner stated that having Landsman et al. in conjunction with Galomb, an advertiser would have the ability to change its advertisements by modifying the text, image or hyperlink associated with the advertisement. The Examiner

concluded that it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified Landsman with Galomb's advertising system to enable since it would have provided the benefit of the need for advertisers to directly and instantly control the testing and optimizing of their advertisements. Applicants respectfully traverse the rejection.

Applicants respectfully submit that the method in Claim 1 is non-obvious based on Landsman for the same reasons as given for Claim 1 above. Further, Applicants respectfully submit that Galomb does not teach or suggest generating a creative on the server-side as claimed in Claim 1. Applicants respectfully submit, therefore, that Landsman and Galomb, either singly or in any theoretical combination, do not teach or suggest the method of Claim 1. Claims 6-8 depend directly or indirectly from Claim 1 and are thus respectively submitted as being non-obvious based on Landsman in view of Galomb for the same reasons given above for Claim 1.

Further, it is respectfully submitted that the mere disclosure in Galomb that an advertisement may have text and images and disclosing a testing method for such advertisements, does not teach or suggest the step of periodically changing text or images, as claimed in Claim 6. Applicants respectfully submit that Claim 6 is non-obvious based on Landsman in view of Galomb for this additional reason.

Claims 14-16 are generally system counterparts of Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Claims 23-25 are method claims similar to Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Claims 30-32 are generally system counterparts of Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Claims 40-42 are method claims similar to Claims 6-8 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Claims 48-50 are generally system counterparts of Claims 6-8 and thus are respectfully
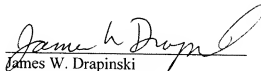
submitted as being non-obvious based on Landsman in view of Galomb for the same reason given above for Claims 6-8.

Conclusion

For the above reasons, Applicants respectfully submit that all pending claims, Claims 1-52, in the present application are allowable. Such allowance is respectfully solicited.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 984-8200.

Respectfully submitted,

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